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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,204	12/22/1999	SATOSHI NISHIKAWA	862.3177	5888

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EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 08/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/470,204

Applicant(s)

NISHIKAWA ET AL.

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5749024 to Young. The Young reference discloses all the limitations as recited in claim 14. See col. 5, lines 17-29 for more details. Young discloses an automatic electronic printing order control systems that automatically select the output of the paper sheet first or the output of the transparency sheet first for the same output contents.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 & 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5177543 to Rodenberg et al (hereafter Rodenberg) in view of U.S. Patent No. 5869824 to Okada et al (hereafter Okada) and further in view of U.S. Patent No. 5709374 to Taylor et al (hereafter Taylor). The Rodenberg reference discloses blank sheets may be used as separation page to be inserted between adjacent transparencies. The separator sheets may be blank or may contain the same information as the adjacent transparencies, see col. 3, lines 62-67. Rodenberg

does not disclose expressly a method and apparatus for separation check and to insert separation page after each page of the output is printed if the printing is in ascending order, and to insert separation page before each page of the output is printed if the printing is in descending order. Okada reference discloses a printing control method and apparatus to check whether or not the banner page (as equivalent to predetermined medium) has been added to the printing jobs, see col. 4, lines 45-49. Combination of Rodenberg and Okada do not teach the method of checking the printing is in ascending or descending order. The Taylor reference discloses banner sheets is automatically inserted before or after the printing of the first or last sheets of each print job; see col. 1, lines 35-40 for more details. Rodenberg, Okada, and Taylor are combinable because they from the same field of endeavor for printing control method and apparatus. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add a printing control method and apparatus for checking printing order and separation printing as per disclosure of Okada and Taylor to Rodenberg invention. The suggestion/motivation for doing so would have been to solve the problem of transparencies sticking together. Therefore, it would have been obvious to combine Taylor with Okada and Rodenberg to obtain the invention as specified in claims 1 & 7.

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rodenberg, Okada, and Taylor as applied to claim 1 above, and further in view of U.S. Patent No. 5282050 to Ishizuka et al (hereafter Ishizuka). Rodenberg, Okada, and Taylor do not disclose expressly the method for checking and invalidating a saving state setting (page having no output data is not output). Ishizuka discloses a method of checking to determine whether each of the received

pages is an ineffective page (as equivalent to "page having no output data"). When an ineffective page is determined, no recording is performed for the corresponding page; see col. 5, lines 44-64 and Figure 7 for more details. Rodenberg and Ishizuka are combinable because they are from the same of endeavor for printing control and apparatus. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement a saving state checking method as per teachings of Ishizuka to the invention of Rodenberg, Okada, and Taylor. Since Ishizuka invention discloses a method to check and disable blank page (no output data) not to be printed, therefore, it is known in the art that his invention has the capability to reverse its function (that is, invalidating the saving state to print out the blank page). The suggestion/motivation for doing so would have been to reduce recording medium resources. Therefore, it would have been obvious to combine Ishizuka with Rodenberg to obtain the invention as specified in claim 2.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rodenberg, Okada, and Taylor as applied to claim 1 above, and further in view of U.S. Patent No. 5282050 to Ishizuka et al (hereafter Ishizuka). Rodenberg further discloses the separator sheets may be blank or may contain the same information as the adjacent transparency (as equivalent to representing whether a predetermined content is printed on the predetermined medium); col. 3, lines 66-67. Combination of Rodenberg, Okada, and Taylor do not disclose expressly the method for checking and invalidating a saving state setting (page having no output data is not output). Ishizuka discloses a method of checking to determine whether each of the received pages is an ineffective page (as equivalent to "page having no output data"). Since Ishizuka invention

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discloses a method to check and disable blank page (no output data) not to be printed, therefore, it is known in the art that his invention has the capability to reverse its function (that is, invalidating the saving state to print out the blank page). When an ineffective page is determined, no recording is performed for the corresponding page; see col. 5, lines 44-64 and Figure 7 for more details. Rodenberg, Okada, Taylor and Ishizuka are combinable because they are from the same of endeavor for printing control and apparatus. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement a saving state checking method as per teachings of Ishizuka to the invention of Rodenberg, Okada, and Taylor. The suggestion/motivation for doing so would have been to reduce recording medium resources. Therefore, it would have been obvious to combine Ishizuka with Rodenberg, Okada, and Taylor to obtain the invention as specified in claim 3.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rodenberg, Okada, and Taylor as applied to claim 1 above. Rodenberg further discloses printing medium is a transparency film, and predetermined medium (separation sheet) is paper; see col. 2, lines 5-7.

6. Claims 5 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodenberg, Okada, Taylor, and Ishizuka as applied to claim 3 above. It is known in the art at the time of the invention, the predetermined content is the same as a contented printed on the medium of the output.

7. Claims 6 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodenberg, Okada, and Taylor as applied to claim 1 above, and further in view of U.S. Patent No. 6377356 to Sakamoto et al (hereafter Sakamoto). Rodenberg, Okada, and Taylor disclose all the limitations as recited in claim 6 as applied to claim 1 above, but do not disclose expressly the method for converting the predetermined data into another format and saving the converted data as a spool file, then mapped the spool file to the printing device. Sakamoto discloses a method for converting predetermined data into a print data and sends it to the printing device. See Figure 1 and col. 3, lines 4-13 for more details. Rodenberg, Taylor, Okada, and Sakamoto are combinable because they are from the same field of endeavor for printing and control apparatus. At the time of the invention, it would have obvious to a person of ordinary skill in the art to add the conversion and mapping steps to the inventions of Rodenberg, Okada, and Taylor. The suggestion/motivation for doing so would have been improved printing speed and double-side printing capability. Therefore, it would have been obvious to combine Rodenberg, Okada, and Taylor with Sakamoto to obtain the invention as specified in claims 6 & 12.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5481353 to Rodenberg et al (hereafter Rodenberg) in view of U.S. Patent No. 5869824 to Okada et al (hereafter Okada) and further in view of U.S. Patent No. 5709374 to Taylor et al (hereafter Taylor). The Rodenberg reference discloses blank sheets may be used as spacer sheets to be inserted between adjacent transparencies. The separator sheets may be blank or may contain the same information as the adjacent transparencies, see col. 3, lines 62-67. Rodenberg does not disclose expressly a method for separation and printing order check. Okada reference discloses a printing control method and apparatus to check whether or not the banner page (as equivalent to

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separation page) has been added to the printing jobs; see col. 4, lines 45-49. Okada further discloses a storage medium for storing a computer program, which can be executed by an apparatus; see Figure 1, reference #14. The Taylor reference discloses banner sheets is automatically inserted before or after the printing of the first or last sheets of each print job; see col. 1, lines 35-40 for more details. Rodenberg, Okada, and Taylor are combinable because they from the same field of endeavor for printing control method and apparatus. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add a printing control method and apparatus for checking printing order and separation printing as per disclosure of Okada and Taylor to Rodenberg invention. The suggestion/motivation for doing so would have been to solve the problem of transparencies sticking together. Therefore, it would have been obvious to combine Taylor with Okada and Rodenberg to obtain the invention as specified in claims 1 & 7.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6301013 to Momose et al.

U.S. Patent No. 5881212 to Morita.

U.S. Patent No. 5316279 to Corona et al.

U.S. Patent No. 5481353 to Hicks.

U.S. Patent No. 5889594 to Mackawa.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-5397 for regular communications and (703)308-5397 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

tp
July 28, 2003



DAVID MOORE
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